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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,726	01/17/2002	Allan Paul T. Uy	ST01015USU(133-US-U1)	8643
34408 7590 08/21/2008 THE ECLIPSE GROUP LLP 10605 BALBOA BLVD., SUITE 300 GRANADA HILLS, CA 91344				
EXAMINER KAPLAN, HAL IRA				
ART UNIT 2836		PAPER NUMBER		
MAIL DATE 08/21/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/051,726

Applicant(s)

UY ET AL.

Examiner

Hal I. Kaplan

Art Unit

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CIS-100)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 4/28/08

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 17, 2008 has been entered.

Specification

2. The disclosure is objected to because of the following informalities: Page 8, line 2, "V2 202" should be "V2 112".

Appropriate correction is required.

Drawings

3. The drawings were received on June 17, 2008. These drawings are accepted.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (admission) in view of the US patent of Wagner (4,788,450).

As to claims 1 and 6, admission teaches all of the claimed features except for the claimed FET coupled to the secondary power source and the claimed inverter coupled to a gate of the FET (see Figure 1). Wagner discloses an apparatus for providing power from a secondary power source comprising a FET (310) coupled to the secondary power source (350) and to a device to be powered (316); and an inverter (381), coupled to a gate of the FET (310), wherein the inverter (381) maintains the FET (310) in a pinched-off condition and preventing a current flow from the secondary power source (350) when the primary power source (306) is available (see column 5, lines 1-3;

column 5, line 66 - column 6, line 26; and Figure 3). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified admission by connecting the FET (310) of Wagner between the first diode and the secondary power source, and connecting the inverter (381) of Wagner between the FET (310) and the switch (114) of admission, with its control signal coupled directly to the primary power source, in order to completely isolate the secondary source when the primary source is present, thus preventing the secondary source from unnecessary depletion. Admission in view of Wagner do not disclose the relative potentials of the primary and secondary power sources; however, selections of values of components and operational levels for an electronic device are engineering decisions based upon the system's intended use and the expected requirements of the other systems with which it will interface. See MPEP §2144.04(IV)(A). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claims 2-5 and 7-10, the FET of Wagner may be either n-channel or p-channel (see column 8, lines 7-10), but Wagner does not specify whether the FET is a depletion mode FET or an enhancement mode FET. In the Office action dated December 24, 2003, the Examiner took official notice that n-channel depletion mode FETS and p-channel enhancement mode FETS are well-known switching equivalents in

the art of semiconductor power switching. Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the circuit of admission in view of Wagner by using either depletion mode or enhancement mode FETS, because they are well-known in the art as switching equivalents.

Response to Arguments

8. Applicants' arguments, see Remarks, filed June 17, 2008, with respect to the objection to the drawings and the rejection of claims 1-10 have been fully considered and are persuasive. The objection to the drawings and the rejection of claims 1-10 has been withdrawn. Although the Examiner does not necessarily agree with Applicants' arguments regarding the potential typographical error in Figure 16 of the Staffiere reference, or that Applicants' admitted prior art and the Staffiere circuit cannot be combined, Applicants' arguments regarding not all claim limitations being taught or suggested by the cited art are persuasive, and the rejection of claims 1-10 over Applicants' admitted prior art in view of Staffiere is hereby withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal I. Kaplan whose telephone number is 571-272-8587. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Sherry can be reached on 571-272-2084. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hik

/Stephen W Jackson/
Primary Examiner, Art Unit 2836